

Request for Reconsideration
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REMARKS

Claims 1-24 and 26-30 were presented for examination. The final Office Action dated September 20, 2005 rejects claims 1-24 and allows claims 26-30. Claims 1-24 and 26-30 remain pending in the application.

The final Office Action rejects the Applicants' argument that Huang is disqualified as prior art against the Applicants' claimed invention under 35 U.S.C. 103(c)(1). The reason provided by the final Office Action is as follows:

"Revised 35 U.S.C. 102(e) only applies to Applications filed on or after November 2000. In this instance, the Application was filed on August 24, 2000. Such rule does not apply to the application. Therefore, the US Patent 6,292,829 is indeed qualified as prior art under 35 U.S.C. 103(a) rejection."

Applicants respectfully disagree with this rationale. For one, the rule that is relevant to the filing date of the Applicants' patent application is 35 U.S.C. 103(c), and not 35 U.S.C. 102(e). The final Office Action is rejecting the Applicants' invention under 35 U.S.C. 103(a), not 35 U.S.C. 102(e). And the Applicants' argument is that Huang cannot be used as prior art for purposes of 35 U.S.C. 103(a), because of rule 35 U.S.C. 103(c).

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As for the effective date of 35 U.S.C. 103(c), the change to 35 U.S.C. 103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. (Please see the Notice in the U.S. Patent Office's Official Gazette, dated April 11, 2000, titled "American Inventors Protection Act", a copy of which is attached herewith.) The Applicants' patent application was filed August 4, 2000, which is after the date of enactment. Therefore, rule 35 U.S.C. 103(c) applies to the Applicants' patent application.

Moreover, according to the Notice, "Subject matter which was qualified under former 35 U.S.C. 103(c) via 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Applicants demonstrated in their previous paper that these criteria were met.

Consequently, Applicants respectfully submit that any rejection of the Applicants' claims based on Huang in view of Parvathaneny is rendered moot. Applicants therefore respectfully request that the rejection of the claims be withdrawn.

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CONCLUSION

In view of the arguments made herein, Applicants submit that the application is in condition for allowance and requests early favorable action by the Examiner.


In addition, the Applicants' representative respectfully requests a telephonic interview with the Examiner before he makes a decision upon this Request for Reconsideration. The Examiner is cordially invited to call the undersigned at (508) 303-0932.

Authorization is hereby granted to apply any credits or fees due in this case not covered by check to Deposit Account 50-2295.

Respectfully submitted,

Date: 12-20-05
Reg. No. 41,274

Fax No.: (508) 303-0005
Tel. No.: (508) 303-2003


Michael A. Rodriguez
Attorney for Applicants
Guerin & Rodriguez, LLP
5 Mount Royal Avenue
Marlborough, MA 01752

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Guidelines Concerning the Implementation of
Changes to 35 USC 102(g) and 103(c) and the
Interpretation of the Term "Original Application"
in the American Inventors Protection Act of 1999

On November 29, 1999, the American Inventors Protection Act of 1999 (hereinafter "Act") was enacted.¹ This notice addresses several of the changes created by the Act which do not require rulemaking to implement. First, the Patent and Trademark Office (PTO) is hereby setting forth guidelines to establish its interpretation of the changes made to 35 U.S.C. 102(g) and 103(c). Second, the PTO is hereby setting forth an interpretation of the term "original application" to clarify the application of the Option Inter Partes Reexamination Procedure created in Subtitle F of the Act. Further, this notice instructs patent examiners and the public on how to implement these changes and addresses situations that are anticipated to arise in the future.

An O.G. notice stating the PTO's interpretation of 35 U.S.C. 102(e) as amended by the Act is expected to be published in the near future. The notice will also include guidelines for implementing the amended 102(e) and illustrative examples.

I. Guidelines To Implement Changes in 35 U.S.C. 102(g)

Section 4806 of the Act amended 35 U.S.C. 102(g) to read as follows:

A person shall be entitled to a patent unless-

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

The effective date of this change to 102(g) is the date of enactment, November 29, 1999. Amended 102(g) will apply to all interference proceedings involving applications pending on November 29, 1999 since this change merely ratifies an existing interpretation of the law. The significant features resulting from this amendment to 102(g) are the following:

(1) Amended 102(g) makes it explicitly clear that a party involved in an interference proceeding under 35 U.S.C. 135 or 291 may establish a date of invention under 104. 35 U.S.C. 104, as amended by GATT (Public Law 103-465, 108 Stat. 4809 (1994)) and NAFTA (Public Law 103-182, 107 Stat. 2057 (1993)), permits a party to establish a date of invention in a NAFTA member country on or after December 8, 1993 or in WTO member country other than a NAFTA member country on or after January 1, 1996.

(2) Apart from interference proceedings under 35 U.S.C. 135(a), and ex parte examination following an interference to enforce the judgment in

the interference and the estoppel provisions of 37 CFR 1.658(c) [see also *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (party losing interference is not entitled to claims to same patentable invention as count--based on estoppel) and *Ex parte Tytgat*, 225 USPQ 907 (Bd. App. 1985) (same)], evidence of a date of invention in a NAFTA or WTO country other than the United States will not be considered prior art under 102(g), as amended.

(3) No change is anticipated in 37 CFR 1.131 practice, which will continue to require diligence until reduction to practice. In *re Bickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), states that Rule 131 practice is not necessarily controlled by the laws pertaining to interference. In addition, through a Rule 131 affidavit, parties will be able to continue to show evidence of the date of invention in a NAFTA member country and a WTO member country to the extent permitted by 35 U.S.C. 104.

Implementation Steps As to Amended 35 U.S.C. 102(g)

Since the amendment to 102(g) merely ratifies an existing interpretation of the law, no changes in practice are needed.

II. Guidelines To Implement Changes in 35 U.S.C. 103(c)

Section 4807 of the Act amended 35 U.S.C. 103(c) to read as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This change to 103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. American Inventors Protection Act of 1999, Pub. L. No. 106-113, Sec. 4807(b). This amendment to 103(c) does not apply to any application filed before November 29, 1999, any request for examination under 37 CFR 1.129 of such an application nor any request for continued examination, which is defined in section 4403 of the Act, of such an application. The significant features resulting this amendment to 103(c) are the following:

(1) Subject matter which was prior art under former 35 U.S.C. 103(c) via 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

(2) The mere filing of a continuation application on or after November 29, 1999 will serve to exclude commonly owned 102(e) prior art that was applied, or could have been applied, in a rejection under 103 in the parent application. For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for which reissue is being sought. See (4) below for further explanation.

(3) This amendment applies only to prior art usable in an obviousness rejection under 103. Subject matter that qualifies as anticipatory

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prior art under 102, including 102(e), is not affected, and may still be used to reject claims as being anticipated.

(4) The recapture doctrine may prevent the presentation of claims in reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made.

(5) The burden of establishing that subject matter is disqualified as prior art is placed on the patent applicants once the patent examiners have established a prima facie case of obviousness based on the subject matter.

(6) Nonstatutory and statutory double patenting rejections, based on subject matter now disqualified as prior art in amended 103(c), may still be made by patent examiners.

Implementation Steps As to Amended 35 U.S.C. 103(c)

A. Applications To Be Considered.

(1) The amendment of 103(c) "... shall apply to any application for patent filed on or after the date of enactment of this Act," which is November 29, 1999. Therefore, amended 103(c) will be applied to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d) and reissues. Reexaminations proceedings are not "any application for patent." Therefore, this amendment to 103(c) does not apply to reexamination proceedings.

(2) Amended 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129(a) of such an application nor a request for continued examination (defined in section 4403 of the Act) of such an application.

B. Examination Procedure with respect to amended 103(c).

(1) Examiners are encouraged to check the assignment records, which are available on the Patent Application Locating and Monitoring (PALM) system, for the patents and applications involved in any rejection to see if there is a possible common owner or assignee with the application being examined. Since examiners should always apply potentially commonly owned or assigned prior art, the review of assignment records is only to indicate to the examiner whether making one or more appropriate back up rejections should be considered. The assignment records on PALM show the execution date of any recorded assignment. Since applicants are not required to record assignments, however, these records are not the exclusive means to determine whether there was common ownership at the time the invention was made. In addition, the Office records other papers, such as employment contracts, which are not evidence of common ownership. Therefore, the examiners should be careful to refer to the box labeled "Brief" on the bottom of the PALM screen which provides a brief description of the paper recorded as stated by the applicant. Examiners should not fail to apply a reference believed to be commonly owned at the time of the invention based only upon the data in PALM. The assignment information in PALM, however, may give an examiner a warning that a reference may be disqualified by the applicant in the future.

(2) Applications and patents will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if:

(a) the applicant provides evidence that the application and patent files refer to assignments recorded in the PTO in accordance with 37 CFR 3.11 which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention;

(b) copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention are filed in each of the applications and patents;

(c) an affidavit or declaration by the common owner is filed which states that there was common ownership at the time the invention was made and explains why the affiant believes there was common ownership; or

(d) other evidence is submitted which establishes common ownership of the applications and patents at the time the invention was made, e.g., a court decision determining the owner. In circumstances where the common owner is a corporation or other organization, an affidavit or declaration averring ownership may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization.

(3) If the application file being examined does not establish that it and the reference patent(s) or application(s) are owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, the examiner will:

(a) assume the application(s) and patent(s) are not commonly owned;

(b) examine the application on all grounds other than any conflict between the reference patent(s) or application(s) arising from a possible 103 rejection based on 102(e), (f) and/or (g);

(c) consider the applicability of any references under 103 based on 102(e), (f) and/or (g), including provisional rejections under 35U.S.C. 102(e)/103; and

(d) apply the best references against the claimed invention by making rejections under 102 and 103, including any rejections under 103 based on 102(e), (f) and/or (g), until such time that proof is submitted that the application(s) and patent(s) were commonly owned, at the time the invention was made (see (2) above). When applying any 102(e)/103 references against the claims, the examiner should anticipate that an affidavit (or other adequate proof) averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 103 based on 102(e). If such an affidavit (or other adequate proof) is filed in reply to the 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made.

(4) If the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made, the examiner will:

(a) examine the applications as to all grounds except 102(e), (f)

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and (g) as they apply through 103, including provisional rejections under 35 U.S.C. 102(e)/103;

(b) examine the applications for double patenting, including statutory and nonstatutory double patenting, and make a provisional rejection, if appropriate; and

(c) invite the applicant to file a terminal disclaimer to overcome any provisional or actual nonstatutory double patenting rejection, if appropriate.

III. Interpretation of the term "original application" to clarify the application of the Optional Inter Partes Reexamination Procedure

Section 4608 of the Act states the effective date and applicability of the Optional Inter Partes Reexamination Procedure established by Subtitle F of the Act. Specifically, Section 4608 states that the changes in Subtitle F "... shall take effect on the date of enactment of this Act and shall apply to any patent that issues from an original application filed in the United States on or after that date."

The phrase "original application" is interpreted to encompass utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications. This interpretation is consistent with the use of the phrase in 35 U.S.C. 251 and the federal rules pertaining to reexamination. In addition, section 201.04(a) of the Manual of Patent Examination and Procedure (MPEP) defines an original application as "... an application which is not a reissue application." Section 201.04(a) of the MPEP further states that "[a]n original application may be a first filing or a continuing application." Therefore, the Optional Inter Partes Reexamination Procedure is applicable to patents which issue from all applications (except for reissues) filed on or after November 29, 1999. A patent which issued from an application filed prior to November 29, 1999 with a request for continued examination (defined in section 4403 of the Act) on or after May 29, 2000, however, is not eligible for the Optional Inter Partes Reexamination Procedure. A request for continued examination is not considered a filing of an application

FOR FURTHER INFORMATION CONTACT: Jeanne Clark or Robert Clarke, Legal Advisors in the Special Program Law Office, by telephone at (703) 305-1622, by fax at (703) 305-1013, or by e-mail addressed to Jeanne.Clark@USPTO.gov or Robert.Clarke@USPTO.gov.

Stephen G. Kunin
Deputy Assistant Commissioner
for Patent Policy and Projects

1The American Inventors Protection Act of 1999 is a part of the conference report (H. Rep. 106-479) on H.R. 3194, Consolidated Appropriations Act, Fiscal Year 2000. The text of the American Inventors Protection Act of 1999 is contained in title IV of S. 1948, the Intellectual Property and Communications Omnibus Reform Act of 1999 (Public Law 106-113).